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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,467	12/27/2001	Hidehei Kageyama	NO. 49	7790

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EXAMINER

PRÜNNER, KATHLEEN J

ART UNIT PAPER NUMBER

3751

DATE MAILED: 05/17/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,467

Applicant(s)

KAGEVARNA ET AL.

Examiner

Kathleen J. Prunner

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-19 is/are allowed.
- 6) ☒ Claim(s) 1, 4-10 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1. The request filed on November 6, 2003 (Paper No. 13) for a Request for Continued Examination (RCE) under 37 CFR 1.114 (a)(3) based on parent Application No. 10/026,467 is acceptable and an RCE has been established. An action on the RCE follows.

Specification

2. The following informalities in the claims are noted: (A) in claim 1, on line 11, "a tip" should read --the tip-- since line 10 previously recited a tip of the holders; (B) in claims 11, 14 and 16, on line 9, "a the" should read --a--; and (C) in claims 11, 14 and 16, on line 10, "a tip" should read --the tip--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Claims 1, 4 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 now calls for "supporting parts, each of which supports the corresponding holder and movable in an axial direction in the casing together with the holder". However, the originally filed disclosure merely provides support for "a supporting section for supporting the holders to be movable in the axial direction in the casing" (note lines 20-21 on page 3 and the originally filed claim 1 at lines 4-5).

4. Claims 1, 4 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

Art Unit: 3751

art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 now calls for "a feed mechanism, provided in the casing, for selectively advancing one of the 'supporting parts' ". However, the originally filed disclosure merely provides support for "a feed mechanism, provided in the casing, for selectively advancing one of the plurality of holders" (note from line 21 on page 3 to line 1 on page 4 and the originally filed claim 1 at lines 6-7).

5. Claims 1, 4 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 now calls for "each supporting part is adapted to support a section of each holder such that the supported section is adapted to be rotatably supported in relation to the supporting part". However, the originally filed disclosure merely provides support for "the supported section of each holder supported by the supporting section is rotatably supported in relation to the supporting section" (note lines 4-5 on page 4 and the originally filed claim 1 at lines 11-12).

6. Claims 1, 4 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 now calls for "a spherical bearing is formed between 'said supporting part' and the supported section provided on each of said holders, wherein said spherical bearing includes a spherical part formed on either one of 'said supporting part' and the supported section provided on a holder and a concave part formed on the other one of 'said supporting part' and supported section provided on the holder to receive said spherical part". However, the originally filed disclosure merely provides support for "formation of a spherical bearing between the supported section and the supporting section provided on each of the holders would enable the

Art Unit: 3751

supporting section to be rotatably supported by the supporting section” (note lines 19-21 on page 4 and the originally filed claim 2) and “This spherical bearing may include a spherical part formed on either one of the supporting section and the supported section provided on a holder and a concave part formed on the other one of the supporting section and supported section provided on the holder to receive the spherical part” (note from line 21 on page 4 to line 4 on page 5 and the originally filed claim 3).

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 1 contain terms lacking proper antecedent basis. The claim recites the limitations “the corresponding holder” in line 5, and “the holder” in lines 5-6. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1, 4-10 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Schleif. Schleif discloses a composite holding device having all the claimed features including a casing (constituted by bottom part 1 and top part 2) accommodating a plurality of holders or holder bodies (constituted by writing cartridges 22 and 23) holding media (ball point pens), supporting parts (constituted by tubes 17) each of which supports a corresponding holder and is movable in an axial direction in the casing together with the holder (note lines 27-48 in col. 3); a feed mechanism (constituted by nose 14 and cam surface 19, note lines 38-41 in col. 3) provided in the casing for selectively advancing one of the supporting parts 17, and a manipulating

Art Unit: 3751

mechanism (constituted by the barrel part 1, note lines 56-61 in col. 3) for operating the feed mechanism (14, 19) and being adapted to project a tip of one of the holders or writing cartridges 22, 23 out of the end of the casing (note Fig. 1 and note from line 45 in col. 3 to line 3 in col. 4) wherein each supporting part 17 is adapted to support a section of each holder 22, 23 such that the supported section is adapted to be rotatably supported in relation to the supporting part 17 (note lines 52-56 in col. 1), wherein a spherical bearing (constituted by the spherical top of slides 13 (note Fig. 8) and the concave part of the casing 20 (note Fig. 1)) is formed between the supporting part and the supported section provided on each of the holders 22, 23 (note Fig. 1), and wherein the spherical bearing includes a spherical part (constituted by the spherical top of slides 13 (note Fig. 8)) formed on a supported section and a concave part (constituted by the concave part of the casing 20 (note Fig. 1)) is formed by the curved cam surface 19 (note Fig. 1) to receive the spherical part (note Fig. 1). With regard to claims 4 and 10, Schleif also discloses that the media is a writing related media of ink normally used by ball point pens (note lines 6-7 in col. 1). With respect to claim 5, Schleif further discloses that the composite holding device has a cap (constituted by the bottom part 1 of the barrel) into which the composite holding device is built or disposed. With regard to claim 6, Schleif additionally discloses that the cap (constituted by the bottom part 1 of the barrel) can be easily dismantled (note lines 31-33 in col. 1) hence constituting a detachable covering of the holders especially when the media is constituted by ball point cartridges that need to be replaced when the ink has been exhausted. With respect to claim 8, Schleif also discloses a spherical bearing constituted by the spherical top of slides 13 (note Fig. 8). With regard to claim 9, Schleif further discloses that the spherical part is formed on a supported section and a concave part is formed by the curved cam surface 19 (note Fig. 1).

Allowable Subject Matter

12. Claims 11-19 are allowed.

Response to Arguments

13. Applicant's arguments filed October 14, 2003 (Paper No. 8) have been fully considered but they are not deemed persuasive.

14. Applicant's arguments with respect to claims 1, 4 and 5 have been considered but are moot in view of the new ground(s) of rejection.

15. In response to applicant's arguments that the Schleif reference fails to show certain features of applicant's invention, it is pointed out that each holder in the Schleif reference has a spherical bearing constituted by that portion or half of the slider in which each is disposed (note Figs. 4 and 8 of the reference).

16. In response to applicant's arguments that the Schleif reference fails to show a spherical shaped portion, it is pointed out that the each side (as shown in Fig. 8 of the reference) clearly has a spherical portion constituted by the arched portions or segments.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kathleen J. Prunner whose telephone number is 703-306-9044.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3751

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kathleen J. Prunner

May 7, 2004



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